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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,265	10/07/2003	Michael Merves	A8130.0135/P135	3136
24998	7590	11/02/2006	EXAMINER	
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			TYSON, MELANIE RUANO	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 11/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/679,265	Applicant(s) MERVES, MICHAEL	
	Examiner Melanie Tyson	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is in response to applicant's amendment received on 28 September 2006.

Drawings

1. The replacement drawings were received on 28 September 2006. These drawings are acceptable.

Claim Objections

2. The corrections made to the claims are acceptable.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1 and 3-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lizardi in view of Keane et al. (Publication No. US 2003/0204195 A1).

Lizardi discloses a suture device (Figure 6, element 10) comprising an elongated

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shaft (26) having a longitudinal axis (not labeled), a proximal end (portion adjacent element 22), and distal end (54). Figure 6 shows a handle (18) provided at the proximal end (portion adjacent element 22), and a cavity (34) within the handle for storing at least one strand of suture (14; column 4, lines 13-16), wherein the cavity is provided with a hatch (Figure 1, element 44). Figure 1 shows the hatch (44) is a pivotable hatch, since it swings open on an axis via a resilient connecting member (48). Figure 4 shows the hatch (44) forms an angle (not labeled; or is "not integral with the handle") with respect to the longitudinal axis of the elongated shaft (26), wherein the angle is different from a zero degree angle with respect to the longitudinal axis of the elongated shaft (26) when the hatch (44) is in an opened position (the angle shown is about 90 degrees, which falls within the range claimed). Figure 5 shows the hatch (44) forms a zero degree angle (or is "integral with the handle") with respect to the longitudinal axis of the elongated shaft (26) when the hatch (44) is in a closed position. Figure 1 shows the at least one strand of suture (14) is further provided with a needle (16). Figure 7 shows the elongated shaft (26) is configured to accommodate an implantable device (12), wherein the implantable device is a suture anchor (column 4, line 1). Figure 7 further shows the at least one strand of suture (14) provided with the at least one surgical needle (16) is stored within the handle (18) when the pivotable hatch (44) is in the closed position.

Lizardi does not disclose a tie-down bar attached to the hatch (42). Like Lizardi, Keane et al. disclose a suture device (Figure 2, not labeled). Unlike Lizardi, Keane et al. disclose a tie-down bar (Figure 3, not labeled; bar that runs through element 1) attached to a hatch (1; since the spool 1 covers an opening 13 in the handle 8). Keane et al.

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teach the at least one strand of suture (Figure 1, element 6) with the at least one surgical needle (7) is wrapped around the tie-down bar (since the bar runs through element 1) when the pivotable hatch (1) is in the closed position (closed position being defined as when the hatch 1 is inserted in the handle 8). This configuration contributes to an effective way of holding and dispensing, or "deploying," suture thread and suture thread with attached needles (paragraph 6). Therefore, to construct the device of Lizardi with a tie-down bar connected to a hatch as taught by Keane et al. would have been obvious to one of ordinary skill in the art at the time the invention was made in order to further facilitate holding suture thread and to reduce the likelihood of tangles in the suture thread.

Response to Arguments

6. Applicant's arguments filed 28 September 2006 have been fully considered but they are not persuasive. Applicant argues primarily that not all the limitations of the claims presented are disclosed by Lizardi and Keane et al. The device disclosed by Lizardi is a "suture-storing device" since Lizardi discloses the free ends of the suture thread and any attached needles may be "stored" within the cavity of the insertion tool (column 2, lines 52-54).

As defined by Merriam-Webster Collegiate Dictionary, 10th Ed., a "hatch" is "an opening in the deck of a ship or in the floor or roof of a building" or "the covering for such an opening." As shown in Figure 1 of Applicant's drawings, the "pivotable hatch" (50) is shown to be a "covering" for the opening (cavity 49) in the handle (99) when in a closed position. As shown in Figure 4 of Lizardi, element 44 is a "hatch" since it covers

an opening on the base portion (46). Keane et al. also disclose a "hatch" since element 1 in Figure 3, covers an opening in a portion of the handle (8).

Furthermore, Keane et al. disclose a "tie-down bar." To clarify the "tie-down bar," it comprises the center portion of the hatch (otherwise the sutures will not remain on and rotate with the hatch for deployment), which also includes the unlabeled extended portions (see Figures 2 and 3). Since the bar comprises the center portion of the hatch and the sutures wrap around the hatch throughout the entire hatch, the sutures are wrapped "around" the tie-down bar.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-9062. The examiner can normally be reached on Monday through Thursday 9:00 a.m. - 6:30 p.m., alternate Fridays 9:00 a.m. - 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson 
October 30, 2006


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

10/30/06